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Docket No. 57155-AA/JPW/ANX

1646  
Box 520

In re application of: Christophe P.G. Gerald, et al.

Serial No.: 09/866,248

Group Art Unit: 1646

Filed: May 25, 2001

Examiner: J. Murphy

For: DNA Encoding Mammalian Neuropeptide FF (NPFF) Receptors And Uses Thereof

Commissioner for Patents  
P.O.Box 1450  
Alexandria, VA 22313-1450

July 7, 2003

Transmitted herewith is an amendment to the above-identified application.

Small entity status of this application under 37 C.F.R. § 1.9 and § 1.27 has been established by a verified statement previously submitted.

a verified statement to establish small entity status under 37 C.F.R. § 1.9 and § 1.27 is enclosed.

No additional fee is required.

The filing fee is calculated as follows:

	NUMBER AFTER AMEND- MENT		HIGHEST NUMBER PREVIOUSLY PAID FOR		NUMBER OF EXTRA CLAIMS PRESENTED		RATE			FEE	
							SMALL ENTITY	OTHER ENTITY		SMALL ENTITY	OTHER ENTITY
Total Claims	31	-	* 28	-	*** 3	x	9	18	-		\$ 54
Indepen- dent Claims	20	-	** 12	-	*** 8	x	42	84	-		\$ 672
Multiple Dependent Claims(s) Presented      Yes <u>  X  </u> No For First Time:							140	280			\$ 0
							TOTAL ADDITIONAL    \$                      726.00 FEE				

\*If the "HIGHEST NUMBER PREVIOUSLY PAID FOR" is less than 20, write "20" in this space.

\*\*If the "HIGHEST NUMBER PREVIOUSLY PAID FOR" is less than 3, write "3" in this space.

\*\*\*If the difference between the "NUMBER AFTER AMENDMENT" and the "HIGHEST NUMBER PREVIOUSLY PAID FOR" is less than "0", write "0" in the space.

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Amendment Transmittal Letter  
Page 2

The "HIGHEST NUMBER PREVIOUSLY PAID FOR" (Total or Independent) is the highest of the "NUMBER AFTER AMENDMENT" in any prior amendment or the number of claims as originally filed.

\_\_\_\_\_ Please charge Deposit Account No. \_\_\_\_\_  
in the amount of \$ \_\_\_\_\_.

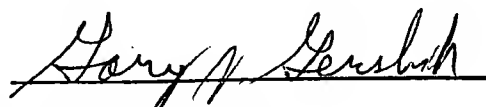
X A check in the amount of \$ 836.00 is enclosed.  
(\$726.00 for additional filing fee and \$110.00 for one-month extension of time)

X The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 03-3125. Three copies of this sheet are enclosed.


X Any filing fees under 37 C.F.R. §1.16 for the presentation of extra claims.

X Any patent application processing fees under 37 C.F.R. §1.17.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450	
	Date <u>7/7/03</u>
Gary J. Gershik Reg. No. 39,992	

Office Action Summary

57155-AA  
Application No.

09/866,248

Examiner

Joseph F Murphy

JPW  
Applicant(s)

GERALD ET AL.

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 76, 77, 97, 98, 107, 108, 134, 135, 142-145, 158, 161, 178-180, 183 and 184 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.

- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

- 8) ☒ Claim(s) 76-77, 97-98, 107-108, 134-135, 142-145, 158, 161, 178-180, 183-184 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.

- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some \* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)

- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

- 5) ☐ Notice of Informal Patent Application (PTO-152)

- 6) ☒ Other: Notice to Comply, CRF Report.

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## **DETAILED ACTION**

### ***Sequence Rules***

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures and CRF Problem Report.

Applicant is given ONE MONTH from the mailing date of this letter within which to comply with the sequence rules, 37 CFR 1.821 - 1.825. Failure to comply with these requirements will result in ABANDONMENT of the application under 37 CFR 1.821(g). Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a). In no case may an applicant extend the period for reply beyond the SIX MONTH statutory period. Direct the reply to the undersigned. Applicant is requested to return a copy of the attached Notice to Comply with the reply.

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 76-77, 97-98, 107-108, 134-135, 142-145, 158, 161, drawn to a method for identifying a chemical compound which binds to a mammalian NPFF receptor, classified in class 435, subclass 7.2.

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- II. Claims 178-180, 183-184, drawn to a process for preparing a pharmaceutical composition, as its reads on, for example, an antibody (see page 44, lines 27-31 of the Specification), classified in class 435, subclass 69.6.

The inventions are distinct, each from the other, for the following reasons:

Inventions I and II are independent and distinct, each from the other, because the structure of the compound produced by the process of Group II is independent of the means of identifying it, especially as the functional assay of Group I would reasonably be expected to identify numerous compounds having distinct structures and functions.

***Advisory Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph F. Murphy whose telephone number is 703-305-7245.


The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 703-308-6564. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-308-0294 for After Final communications.

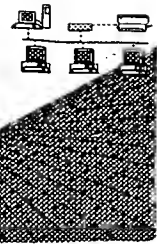
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Joseph F. Murphy, Ph. D.  
Patent Examiner  
Art Unit 1646  
April 22, 2003



YVONNE EYLER, PH.D.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1646



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1600

APPLICANT COPY

## CRF Problem Report

The Scientific and Technical Information Center (STIC) experienced a problem when processing the following computer readable form (CRF):

Application Serial Number: 09/866,248B  
Filing Date: 5/25/2001  
Date Processed by STIC: 11/20/2002

STIC Contact: Mark Spencer, 703-308-4212

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### Nature of Problem:

The CRF (was):

- ☒ (circle one) Damaged or Unreadable (for Unreadable, see attached)
- ☐ Blank (no files on CRF) (see attached)
- ☐ Empty file (filename present, but no bytes in file) (see attached)
- ☐ Virus-infected. Virus name: \_\_\_\_\_ The STIC will not process the CRF.
- ☐ Not saved in ASCII text
- ☐ Sequence Listing was embedded in the file. According to Sequence Rules, submitted file should **only** be the Sequence Listing.
- ☐ Did not contain a Sequence Listing. (see attached sample)
- ☐ Other: \_\_\_\_\_

**PLEASE USE THE CHECKER VERSION 3.1 PROGRAM TO REDUCE ERRORS.  
SEE BELOW FOR ADDRESS:**

<http://www.uspto.gov/web/offices/pac/checker>

Applicants submitting genetic sequence information electronically on diskette or CD-Rom should be aware that there is a possibility that the disk/CD-Rom may have been affected by treatment given to all incoming mail.

Please consider using alternate methods of submission for the disk/CD-Rom or replacement disk/CD-Rom.

Any reply including a sequence listing in electronic form should NOT be sent to the 20231 zip code address for the United States Patent and Trademark Office, and instead should be sent via the following to the indicated addresses:

1. EFS-Bio (<http://www.uspto.gov/ebc/efs/downloads/documents.htm>), EFS Submission User Manual - ePAVE)
2. U.S. Postal Service: U.S. Patent and Trademark Office, Box Sequence, P.O. Box 2327, Arlington, VA 22202
3. Hand Carry directly to:  
U.S. Patent and Trademark Office, Technology Center 1600, Reception Area, 7<sup>th</sup> Floor, Examiner Name, Sequence Information, Crystal Mall One, 1911 South Clark Street, Arlington, VA 22202  
Or  
U.S. Patent and Trademark Office, Box Sequence, Customer Window, Lobby, Room 1B03, Crystal Plaza Two, 2011 South Clark Place, Arlington, VA 22202
4. Federal Express, United Parcel Service, or other delivery service to: U.S. Patent and Trademark Office, Box Sequence, Room 1B03-Mailroom, Crystal Plaza Two, 2011 South Clark Place, Arlington, VA 22202

Revised 01/29/2002

Applicant copy

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submitted disk

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